



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,812	09/15/2003	Martin Heeney	MERCK-2740	7389
23599 7590 11/21/2007 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER TRUONG, DUC	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 11/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/661,812
Filing Date: September 15, 2003
Appellant(s): HEENEY ET AL.

MAILED
NOV 21 2007
GROUP 1700

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/10/2007 appealing from the Office action mailed 05/19/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: the rejection made using Chem Abstract 135: 153178 and 130: 197214 have been withdrawn from consideration.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No prior art has been cited since the only rejection is under 35 U.S.C. 112, first paragraph, description requirement, including new matter situations.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 10-11, and 14-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Note that claim 1 has been amended to include a limitation after the first Office action on the merit "provided that, when b and d are 0 and R2 is H, R1 is not optionally substituted aryl or heteroaryl and not $-\text{SiR}^{\text{oo}}\text{R}^{\text{oo}}$ -substituted alkyl" by the recitation at page 14, paragraph [0035].

Said paragraph has been fully reviewed but it discloses that "when n is 2, R1 is alkyl---". That means it does not have support from the specification since R1 can be other than the amended limitation, such as halogen, hydrogen, P-Sp-, etc--- and R1 doesn't have to be the alkyl group.

Further, it is inconsistent with the teaching from specification since R1 is alkyl with the condition that n is 2, whereas claim 1 discloses that n can be 1 or greater. That means, the specification provides support for the claimed n=2, but not for n=1 or n=3 and greater than 3, as in the claims.

(10) Response to Argument

Appellant's arguments are based on "although the exact words of the proviso are not recited, such is not required for adequate written description under 35 U.S.C. 112, first paragraph". Such arguments have been fully considered but they are not persuasive for the reasons as stated above.

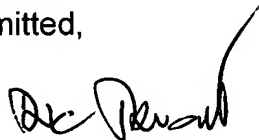
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

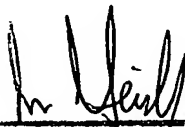
Respectfully submitted,

Duc Truong

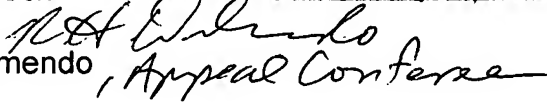


Conferees:

James Seidleck ~~APPEAL CONFEE:~~



Romulo Delmendo


Appeal Conferee